



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,859	10/25/2001	Evan Samuel Dencris	CASE-06816	1101

7590 01/08/2004

MEDLEN & CARROLL, LLP
Suite 350
101 Howard Street
San Francisco, CA 94105

EXAMINER

MITRA, RITA

ART UNIT PAPER NUMBER

1653

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,859

Applicant(s)

EVAN DENERIS

Examiner

Rita Mitra

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status of the Claims

Applicants' preliminary amendment to specification filed April 22, 2002 is acknowledged. Claims 1-4 are currently pending to which the following grounds for rejection are applicable.

Objection to Claims

Claim Rejections - 35 USC § 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The products critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claim 1 and dependent claims 2-4 direct to a method comprising a) providing cells, an expression construct comprising SEQ ID NO: 1 and b) transfecting said cells with said expression construct. Further the method comprises culturing the transfected cells under conditions such that serotonin release is detected (claim 2); and such that seronegic receptor generation is detected (claim 3). The method further comprising contacting said transfected cells with a test compound (claim 4). The specification indicates at page 3 that the present invention relates to compositions and methods of identifying and testing seronegic receptor agonists and

Art Unit: 1653

antagonists. Further the present invention contemplates employing a gene sequence (SEQ ID NO: 1) that encodes a transcription factor for central serotonin 5-HT neurons. The specification further indicates (page 3) that the present invention contemplates a composition comprising isolated DNA having an oligonucleotide sequence of Pet-1 cDNA having the nucleotide sequence of SEQ ID NO: 1. The transcription factor Pet-1 is essential for the method of screening of said agonists and antagonists. Further, while describing the method of screening a compound, the specification indicates at page 5 that cells were contacted with a compound suspected of having the ability to modulate central serotonin 5-HT neuron activity. It is essential to know the test compounds activity for the enablement of the invention. However this has been omitted from the claims. Thus, the particular features considered essential in the specification, is not reflected in the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and dependent claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is not clear what for the method is. Claims 2-4 are included in the rejection because they are depended on rejected claim and do not correct the deficiency of the claim from which they depend.

Claims 2-4 are ambiguous because of using step "c)". Where are the a) and b) steps of the claims?

Art Unit: 1653

Claim 4 is indifferent for the use of the phrase "contacting said transfected cells with a test compound." It is not clear what for the cells are contacting the test compound.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Fyodorov et al. (J. of Neurobiology, vol. 34(2), pp 151-163, 1998). Fyodorov et al. teach a novel ETS domain transcription factor Pet-1, which activates neuronal nAChR gene transcription (see abstract; col 2, under 'Transfection' at page 153; Figs 1 and 2; pages 155-158). The cDNA sequence of Pet-1 has 100% sequence identity to SEQ ID NO: 1 of the instant invention (see "*Rattus norvegicus* ETS domain transcription factor Pet-1 mRNA" Database: GenEmbl; Accession NO: RNU91679; April 7, 1998). The Pet-1 cDNA is considered for the sequence set forth in SEQ ID NO: 1 of instant application (claim 1). Further, Fyodorov et al. also teach use of the DNA in utility and binding assays (Page 158-160) thus anticipating the method of claims 1-4.

Conclusion

No claim is allowed.

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rita Mitra whose telephone number is (703) 605-1211. The Examiner can normally be reached from 9:30 a.m. to 6:30 p.m. on weekdays. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Christopher

Art Unit: 1653

Low, can be reached at (703) 308-2923. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center number is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rita Mitra, Ph.D.

January 5, 2003



ROBERT A. WAX
PRIMARY EXAMINER